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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,409

08/24/2004

Daisuke Kamiya

7378/84103

7763

42798

7590

02/27/2006

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EXAMINER

TRAN, THAO T

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/505,409

Applicant(s)

KAMIYA ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/14/05, 9/14/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to the Amendments filed on 11/28/2005. The IDS filed on 10/14/2005 and 9/14/2005 are acknowledged.
2. Claims 1-12 are currently pending in this application. Claims 9-12 have been newly added.

### ***Election/Restrictions***

3. Newly submitted claims 9-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 9-12 are directed to a process, whereas original claims 1-8 are directed to an article.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-12 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al. (US Pat. 6,559,231) or Okazaki et al. (US Pat. 6,645,617).

Hasegawa discloses a pressure sensitive adhesive sheet for coating a substrate, the pressure sensitive adhesive composition comprising a light curable copolymer (I) obtained by copolymerizing an ethylenically unsaturated monomer (a) having a maleimide group, an ethylenically unsaturated monomer (b) having a carbonyl group, and other ethylenically unsaturated monomer (c) (see abstract; col. 2, ln. 26-32).

Monomer (a) having a maleimide group is a compound having Formula (1), wherein R1 and R2 each can be independently a hydrogen or an alkyl group (see col. 2, ln. 32-67), which reads on the formula in instant claims 1 and 5. Monomer (a) is an imide compound including imide (meth)acrylate that is produced from an acid anhydride, amino alcohol, and (meth)acrylic acid (ester) (see col. 3, ln. 39-41). Monomer (c) includes alkyl (meth)acrylate and hydroxyalkyl (meth)acrylate (see col. 4, ln. 21-29). Hasegawa further teaches the amount of monomer (a) is 4-20%, monomer (b) 2-25%, and monomer (c) 55-94% (see col. 4, ln. 45-48). Thus, copolymer (I) would inherently have a polyester backbone.

Okazaki discloses a pressure sensitive adhesive composition curable with actinic energy ray and pressure sensitive sheet on a substrate (see abstract; col. 1, ln. 12-19). The pressure sensitive adhesive composition comprises a copolymer comprising 0.1-3% by weight of an imide (meth)acrylate and 97-99.9% by weight of an unsaturated monomer (see col. 3, ln. 54-59). The imide (meth)acrylate has a chemical formula (1), wherein R1 and R1 can be independently a hydrogen or alkyl groups (see col. 2, ln. 12-67). The unsaturated monomer includes (meth)acrylate, unsaturated carboxylic acid, vinyl ester, monoalkyl esters of unsaturated

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dicarboxylic acid (see col. 4, ln. 11-21). Thus, the copolymer would inherently have a polyester backbone.

### ***Response to Arguments***

6. Applicant's arguments filed on 11/28/2005 have been fully considered but they are not persuasive.

With respect to Applicants' argument that Hasegawa does not teach the presently claimed invention because Hasegawa does not specifically disclose the present Formula (1) in which either of R1 and R2 is hydrogen. However, in column 2, lines 40-50, Hasegawa discloses Formula (1), wherein R1 and R2 each represent independently a hydrogen atom or an alkyl group, illustrating the presently claimed invention.

With respect to Applicants' argument that the maleimide copolymer of Hasegawa are all solid at ordinary temperature, it is hereby noted that since Hasegawa teaches the same copolymer, it would inherently have the same properties as presently claimed.

The same arguments are presented in response to the invention of Okazaki.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt  
February 21, 2006

  
**THAO T. TRAN**  
**PATENT EXAMINER**